

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Applicants:</b>	Broderick <i>et al.</i>	<b>Conf. No.:</b>	4352
<b>Serial No.:</b>	10/042,625	<b>Art Unit:</b>	4114
<b>Filing Date:</b>	01/09/2002	<b>Examiner:</b>	Feeney, Brett A.
<b>Title:</b>	A PROJECT MANAGEMENT METHOD FOR OPTIMIZING INFORMATION TECHNOLOGY RESOURCES	<b>Docket No.:</b>	FR920000074US1 (IBME-0252)

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF OF APPELLANTS**

This is an appeal from the Final Rejection dated March 25, 2009 rejecting claims 1 and 4-8. This Brief is accompanied by the requisite fee set forth in 37 C.F.R. 1.17(c).

**REAL PARTY IN INTEREST**

International Business Machines Corporation is the real party in interest.

**RELATED APPEALS AND INTERFERENCES**

Appellant is not currently aware of any prior or pending appeals, interferences or judicial proceedings which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **STATUS OF CLAIMS**

As filed, this case included claims 1-8. Claims 2 and 3 were canceled during prosecution. Claims 1 and 4-8 remain pending, and claims 1 and 4-8 stand rejected and form the basis of this appeal.

## **STATUS OF AMENDMENTS**

No amendment to the claims has been entered subsequent to the Final Office Action dated March 25, 2009.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention provides a project management method for optimizing Information Technology (IT) sites. Below is a concise explanation of the subjected matter defined in the claims which are each involved in this Appeal. In addition, the summary points out elements in the figures that correspond to claim features as well as sections in the specification that discuss the features.

Claim 1 claims a project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment to achieve a cost savings, said method comprising the steps of: defining a project business need, the project business need being discrete and having a fixed duration (*see e.g.*, p. 4, lns. 19-24); defining a project technical need, the project technical need involving resources needed to realize the project business need (*see e.g.*, p. 4, lns. 19-24); determining, according to the project business need, a number of IT sites spread over a geographic area (*see e.g.*, p. 8, lns. 5-17); determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic

area (*see e.g.*, p. 19, ln. 20 - p. 20 ln. 5); grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area (*see e.g.*, p. 23, ln. 5 – p. 24, ln. 3); standardizing processes and methods by: listing processes and methods used in the IT sites as determined (*see e.g.*, p. 32, lns. 6-8); listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed(*see e.g.*, p. 32, lns. 8-10); entering in a database the values of said criteria (*see e.g.*, p. 32, lns. 4-6, FIG. 4, element 420); creating with a graphic user interface an evolutionary image of the values of the criteria (*see e.g.*, p. 32, lns. 10-12); determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface (*see e.g.*, p. 32, lns. 12-19); and, implementing the best processes and methods in the IT sites as determined (*see e.g.*, p. 32, lns. 20-25); and, thereafter physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints (*see e.g.*, p. 36, lns. 11-17, p. 40, lns.15-22).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 1 and 4-8 are unpatentable under 35 USC 103(a) over **Alter** (Alter, Steven; Information Systems: A Management Perspective, 2<sup>nd</sup> Edition, The Benjamin/Cummings Publishing Company, 1996), in view of **Lacity** (Lacity, Mary; Willcocks, Leslie P.; “An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience”, MIS Quarterly, Sept. 1998) and further in view of **Willcocks et al.** (Willcocks, Leslie; Choi, Chong; “Co-operative Partnership and ‘Total’ IT Outsourcing: From Contractual Obligation to Strategic Alliance?”, European Management Journal, March 1995).

## **ARGUMENT**

In the Final Office Action dated March 25, 2009, claims 1 and 4-8 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Alter (Alter, Steven; Information Systems: A Management Perspective, 2<sup>nd</sup> Edition, The Benjamin/Cummings Publishing Company, 1996), in view of Lacity (Lacity, Mary; Willcocks, Leslie P.; “An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience”, MIS Quarterly, Sept. 1998), and further view of Willcocks et al. (Willcocks, Leslie; Choi, Chong; “Co-operative Partnership and ‘Total’ IT Outsourcing: From Contractual Obligation to Strategic Alliance?”, European Management Journal, March 1995).

Appellants respectfully disagree that the cited references, either singly or in combination, teach or suggest each and every claimed limitation of the claimed invention. In fact, the claimed invention differs from the cited art in several important aspects. For example, as discussed in more detail below, with respect to independent claim 1:

- (1) Alter fails to teach or suggest defining a project business need, the project business need being discrete and having a fixed duration;
- (2) Alter fails to teach or suggest determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface;
- (3) Alter fails to teach or suggest determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area; and

(4) Appellants respectfully submit that there is no motivation or suggestion to combine Alter with Lacity and Willcocks to teach or suggest physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints.

Each of these claimed elements missing from the cited references will be discussed below:

**(1) Alter fails to teach or suggest defining a project business need, the project business need being discrete and having a fixed duration.**

The Office cites to Alter, pps. 552-553 and 558-559 for disclosure of this claimed element. Appellants respectfully disagree. Alter simply discusses, in general terms, information system (IS) planning as an integral part of overall business planning. Alter does not disclose defining a specific need, the need being discrete and having a fixed duration. Thus, Alter does not disclose the step of defining a project business need as claimed in the claimed invention.

**(2) Alter fails to teach or suggest determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface.**

The Office cites to the graph on page 573 of Alter as showing this claimed element, and argues that the graph can be “manipulated” by changing the inputs to the graph to alter the output of the graph. While this is true of any graph, the claimed invention specifically states that a graphic user interface (GUI) is used to manipulate the image. In contrast, the graph of Alter is

not indicated as being able to be manipulated by a graphic user interface for use in determining best processes and methods. Thus, Alter does not teach the analyzing or manipulating of the image using the GUI as claimed in the claimed invention.

**(3) Alter fails to teach or suggest determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area.**

The passages of Alter cited by the Office (pp. 551-559 and 564-565) describe data centers that can be located at the corporate headquarters, regional processing centers, site processing center, departments processors, workgroup processors, or at individual client machines. However, these data centers, which the Office equates with the number of IT sites of the claimed invention, are not determined according to a pre-defined business process need. In other words, even though the data centers of Alter may be distributed, Alter does not teach or suggest the manner in which the data centers are determined, much less that which skilled people groups and computer equipment is required inside the geographic area is determined according to a particular pre-defined project business need and a pre-defined technical need.

The cited passages of Alter discusses, in general terms, that different personnel are likely to handle different aspects of an Information System but does not teach that the personnel are determined according to a pre-defined project technical need. In contrast, the claimed invention includes “...determining, according to the project business need, a number of IT sites spread over a geographic area; determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area...” Claim 1. As such, unlike the

data centers and specific personnel of Alter, the number of IT sites and skilled people groups are determined based on specific pre-defined criteria. Thus, Alter does not teach or suggest the determining steps of the claimed invention.

**(5) The combination of Alter, Lacity and Willcocks does not teach or suggest physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints.**

The Office admits that Alter fails to disclose physically consolidating the IT sites of the geographic area. Instead, the Office states that one of skill in the art would have been motivated to combine both Lacity and Willcocks to disclose this claimed element. First, the Office argues that Lacity teaches the following portion of the claimed element: “physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need” because of a passing reference in Lacity to a consolidation of data centers. Lacity, p. 373. Next, the Office argues that Willcocks teaches the latter part of this claimed element, namely that the physical consolidation of IT sites is achieved by “considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints.” However, even assuming, *arguendo*, that this combination was proper, these factors are used by Willcocks in considering outsourcing and not in physical consolidation of IT sites of a company.

Appellants submit that the parsing of this claimed element in an attempt to argue that a combination of these three references discloses the claimed element is improper. Assuming that



one of ordinary skill in the art would be motivated to combine three, only arguably relevant, references, to arrive at the claimed invention is impractical, especially in light of the fact that, as discussed above, the main reference, Alter, fails to teach several claimed elements of the claimed invention. As such, Appellants submit that the combination of Alter, Lacity and Willcocks is improper, but even if, *arguendo*, combined, still does not teach or suggest the determining steps of the claimed invention.

With regard to the Office's other arguments regarding dependent claims, Appellants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Appellants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Appellants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Appellants respectfully submit that claims 1 and 4-8 are allowable.

Respectfully submitted,

/Meghan Q. Toner/

Meghan Q. Toner, Reg. No. 52,142  
Hoffman Warnick LLC  
75 State Street, 14th Floor  
Albany, NY 12207  
(518) 449-0044 - Telephone  
(518) 449-0047 – Facsimile

Dated: June 23, 2009

## CLAIMS APPENDIX

### Claim Listing:

1. A project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment to achieve a cost savings, said method comprising the steps of:

defining a project business need, the project business need being discrete and having a fixed duration;

defining a project technical need, the project technical need involving resources needed to realize the project business need;

determining, according to the project business need, a number of IT sites spread over a geographic area;

determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area;

grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area;

standardizing processes and methods by:

listing processes and methods used in the IT sites as determined;

listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed;

entering in a database the values of said criteria;

creating with a graphic user interface an evolutionary image of the values of the criteria;

determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface; and, implementing the best processes and methods in the IT sites as determined; and, thereafter physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints.

4. The method of claim 1 further repeating, after the step of implementing the best processes and methods, the step of listing criteria, the step of determining best processes and methods, and the step of implementing the best processes and methods.

5. The method of claim 1, further repeating, after the step of determining best processes and methods, the step of listing criteria and the step determining best processes and methods.

6. The method of claim 1 wherein the IT sites are spread over more than one geographic area.

7. The method of claim 1, further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the geographic area.

8. The method of claim 1, further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of claim 1.

## **EVIDENCE APPENDIX**

No evidence has been entered and relied upon in the appeal.

## **RELATED PROCEEDINGS APPENDIX**

No decisions rendered by a court or the Board in any proceeding are identified in the related appeals and interferences section.